

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of Yoshimitsu SAKAGUCHI, et al.

Group Art Unit : 1795

Application No. : 10/530,199

Examiner : Eugenia WANG

Filed : April 4, 2005

Docket No. : 12477/7

For : POLYARYLENE ETHER-BASED COMPOUND
CONTAINING SULFONIC ACID GROUP,
COMPOSITION CONTAINING SAME, AND
MANUFACTURING METHOD THEREOF

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO RESTRICTION REQUIREMENT
AND ELECTION OF SPECIES REQUIREMENT**

Sir:

In response to the Election/Restriction Requirement mailed July 28, 2008, Applicants elect with traverse Group I, claims 1-13, 16, 17, 38, and 39. Because the present application is a national stage application of an international (PCT) application under 35 U.S.C. 371, PCT Rules 13.1 and 13.2 should be followed when considering unity of invention of claims of different categories. *See* Manual of Patent Examining Procedure (MPEP), Eighth edition, §§ 823, 1850 and 1875. Under PCT Rules, “unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term ‘special technical features’ is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art.” MPEP, Eighth edition, §1850. The special technical features of the claims in Group I are the polyarylene ether-based compound of claim 1. Group II, drawn to a method of manufacturing a

compound claimed in Group I, and Group IV, drawn to an ion-conducting membrane comprising the compound according to the claims in Group I, share the special technical features of Group I. Similarly, Group V, drawn to a manufacturing method of the ion-conducting membrane according to the claims in Group IV, also shares the special technical features of Group I. Thus, Groups I, II, IV, and V are related to a single general inventive concept and should have unity of invention. Withdrawal of the Restriction Requirement is requested.

In response to the Election of Species Requirement, Applicants elect with traverse formula (1) in Species 1 and formula (2) in Species 2. With regard to Species 3, in the telephone conversation with Examiner Wang on August 27, 2008, Applicants explained to the Examiner that claim 5 recites the polyarylene ether-based compound according to claim 1, further comprising components represented in formula (5) AND formula (6). In other words, the compound of claim 5 comprises both components represented in formula (5) AND components represented in formula (6). The Examiner agreed that Applicants need not to elect between formula (5) and formula (6) in Species 3. In Species 4, Applicants were not asked to choose between formulas because only formula (7) was given under Species 4. Applicants elect with traverse formula (7) in Species 4. Applicants request that the prior art search be done with formula (1) and (2), with optional inclusion of formulas (5) and (6) for claims 5 and 8, and with optional further inclusion of formula (7). Applicants traverse the election of species requirement because it is incorrect to require an election of a single species in a national stage application under 35 U.S.C. 371. See MPEP §§ 823, 1850, and 1875. The Election of Species Requirement should be withdrawn.

The claims of the elected group I readable on the elected species are as follows. Species 1: claims 1-13, 16, 17, 38 and 39. Species 2: claims 1-13, 16, 17, 38 and 39. Species 3: claims 1-13, 16, 17, 38 and 39. Species 4: claims 1-13, 16, 17, 38 and 39.

In the telephone conversation with the Examiner on August 27, 2008, the Examiner stated that a search for formulas (1) and (2) (without formulas (5), (6) and (7)) will be conducted for the independent claims, such as claim 1. Applicants thank the Examiner for the discussions with Applicants regarding the Election/Restriction Requirement.

If the filing of this paper is deemed not timely, applicants petition for an appropriate extension of time. The petition fee, and any other fees that may be required in relation to this paper, can be charged to Deposit Account 11-0600.

Respectfully submitted,

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Dated: August 28, 2008

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